

REMARKS/ARGUMENTS

This Amendment and the following remarks are intended to fully respond to the Final Office Action dated December 13, 2005. In that Office Action, claims 1, 3-9, 11-14 and 16-21 were examined. Claims 3, 16, and 17 have been objected to because of informalities. Claims 1, 9, 14 and 18 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; and claims 1, 3-9, 11-14 and 16-21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Ansell et al. (USPN 6,151,631). Reconsideration of these rejections, as they might apply to the original and amended claims in view of these remarks, is respectfully requested.

In this Amendment, claims 1, 3, 9, 14, 16, and 18 have been amended. Claims 7, 17 and 21 have been canceled; and no new claims have been added.

Summary of Interview -- January 24, 2006

The undersigned and Timothy Scull thank Examiner Patrice Winder for the telephone interview conducted on January 24, 2006. In the interview, the undersigned described the general focus of the claimed invention to Examiner Winder. Specifically, the undersigned emphasized the aspect of the present invention of using mapping requests (requests for maps). The undersigned argued that the difference between the claimed invention and the Ansell reference (US Patent No. 6,151,631) is the use of requests for maps of geographic locations.

Only claims 1 and 7 were specifically discussed. The outstanding rejection under 35 USC § 112, first paragraph was discussed. The Examiner indicated that the rejection could potentially be overcome by amending claim 1 to more specifically recite that the mapping requests were for maps of a geographic location. Additionally, the Examiner indicated that, potentially, the use of mapping requests could be a distinguishing feature of the claimed invention over the Ansell reference.

The Examiner and the undersigned discussed amending claim 1 to specifically recite that the mapping requests are for maps of a geographic location and to include the limitation of claim 7. However, no specific agreement on claim amendments, or the allowance of claims, was reached.

Claim Objections

Applicant respectfully requests that the objections to claims 3 and 16 be withdrawn, because appropriate correction has been made to their dependencies in the present Amendment. Claim 17 has been cancelled.

Claim Amendments

Based on the interview of January 26, 2006, the Applicant believes that the amendments made herein to independent claims 1, 9, 14 and 18 overcome the Examiner's previous rejection of the claims. However, should the Examiner continue to maintain the previous rejection of the claims, the Applicants submit the following arguments.

Claim Rejections – 35 U.S.C. § 112

Claims 1, 9, 14 and 18 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner asserts that the disclosure lacks written description for the term "mapping requests."

Firstly, Applicant points out that the term "mapping requests" was claimed in the originally filed claims and is described in the Detailed Description at least on pages 5-10. As stated in the Manual of Patent Examining Procedure (MPEP) § 2163, "there is a strong presumption that an adequate written description of the claimed invention is present when the application is filed." Accordingly, the examiner must overcome this strong presumption in order to show that the term "mapping requests" does not meet the written description requirement.

The standard for determining whether a disclosure complies with the written description has been described by the Court of Appeals for the Federal Circuit (CAFC) as, "if a person of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate written description requirement is met." *In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1584 (Fed. Cir. 1996). An applicant may show that an invention is complete by disclosure of sufficiently detailed, relevant identifying characteristics which provide evidence that applicant was in possession of the claimed invention. *See MPEP* § 2163 (citing *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 323 F.3d 956, 63 USPQ2d

1609, 1613 (Fed. Cir. 2002)). Thus, as the relevant authority indicates, Applicant does not have to disclose every detail of a “mapping request,” so long as enough relevant characteristics are described to allow someone of ordinary skill in the art to understand what is meant by “mapping request.”

Applicant notes that "mapping request" is not a complicated concept, and simply means a request for a map of some geographical feature or location. The Detailed Description at page 5, paragraph [0011] describes a mapping server computer 110 that may include mapping software 112 that processes mapping requests. Throughout the Detailed Description, “mapping requests” are described in relation to “mapping software” that processes the mapping requests. For example, page 6, paragraph [0012] of the Detailed Description describes “multiple personal computing devices 130 are coupled to the Internet and submit mapping requests which may be serviced by the mapping software on the mapping server 110.” Additionally, at page 6, paragraph [0014] the Detailed Description states that “[i]n one embodiment, the mapping software on the mapping server receives and satisfies numerous mapping requests received from personal computing devices and other network hosts, including other servers, not shown.” *Detailed Description*, page 6, paragraph [0014].

From this description, someone of ordinary skill in the art, in determining the meaning of “mapping requests,” would be prompted to consider the types of software referred to in the art as “mapping software.” Software that provides maps of geographic features such as streets, roads, cities, topography etc. is a very common type of software referred to as “mapping software” as evidenced by the web articles listed below and included in Appendix A.

1. Press Release: Freeware Surveying and Mapping Software Débuts, November 1, 2000, Soft Tree Technical Systems Inc. website <<http://www.softtree.com/events/press5.htm>> (downloaded on December 28, 2005).
2. Golfers Rejoice! Golf and Mapping Powerhouses Join Forces to Release Invaluable Golf CD-ROM, May 24, 2000, and IntelliGolf web site <<http://www.intelligolf.com/pr060100.html>> (downloaded on December 28, 2005).
3. Magellan Announces the GPS Companion For the Handspring Visor, November 10, 2000, Marcosoft Web Site, <<http://www.marcosoft.com/News/GPSCompanionPR.htm>> (downloaded on December 28, 2005).

Moreover, the Detailed Description also makes clear that the mapping requests relate to geographic regions, as indicated by the following quote from page 7, paragraph [0015] of the Detailed Description:

In one embodiment, the analyzer software delimits the entire world, or a portion thereof, into defined geographic regions and populates each of the regions with network addresses such as Internet Protocol (IP) addresses based on mapping requests issued from the IP address. That is, for each *mapping request falling in a defined geographic region*, the network address of the network user issuing the mapping request is associated with *the particular geographic region in which the mapping request falls*.

Detailed Description, page 7, paragraph [0015] (emphasis added). Additionally, at page 10, paragraph [0022] the Detailed Description states:

For example, if 10,000 mapping requests have been stored all of which have the same or similar first three bytes of IP address from originating users, and 5,000 of the mapping requests are for a first region, 3,000 of the mapping requests are for a second region, 1,000 requests are for a third region and 500 mapping requests are each for fourth and fifth regions, then a response to an IP address to location translation for an IP address having the same or similar IP address may include the first region and may include a high rating.

Detailed Description, page 10, paragraph [0022].

Accordingly, someone of ordinary skill in the art would understand that the “mapping requests,” which are processed by “mapping software,” must relate to a request for a street, road, city, topography, etc. map of some *geographic region*. Applicant respectfully submits that the description, although susceptible to characterization by the Examiner as not explicit, is described in enough detail to allow someone of ordinary skill in the art to understand what is meant by “mapping request.”

For at least these reasons, claims 1, 9, 14 and 18 satisfy the written description requirement, and Applicant respectfully requests that the rejection under 35 U.S.C. § 112, first paragraph, be withdrawn.

Claim Rejections – 35 U.S.C. § 102(e)

Claims 1, 3-9, 11-14 and 16-21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Ansell et al. (USPN 6,151,631), hereinafter “Ansell.” Applicant respectfully traverses the § 102(e) rejections.

Ansell teaches a methodology for determining a remote computer location that involves accessing an allocation database, such as RIPE. *See Ansell*, col. 5, lines 15-23. These allocation databases provide information about IP addresses and the contact information provided by the registering entity that is allocated the IP address. *See Ansell*, col. 5, lines 24-30. The contact information is an address or other information for the registrant of the IP address and does not necessarily correspond to the actual geographic location of the IP user having the IP address. The description in Ansell is similar to the “whois” method described in the present disclosure. *See Background*, page 2, paragraph [005].

As previously described, applicant’s invention is a method for determining a geographical location of a network user from mapping requests, and the network addresses associated with those mapping requests. In one embodiment, a mapping server receives a plurality of mapping requests, which contain geographic information and originate from a particular network or IP address. The geographic information and the network addresses are associated in a database. After accumulating many associated sets of geographic information and network addresses, a geographic location for a new network address can be determined. By finding a similar network address in the database to the new network address, a geographic location, for the similar network address, can be used as the geographic location of the new network address.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131 (*quoting Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). “The identical invention must be shown in as complete detail as is contained in the ... claim.” MPEP § 2131 (*quoting Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)).

Ansell does not teach all of the claim limitations of claim 1, and in particular the use of “mapping requests,” as claimed in claim 1 and described in the present application. Ansell does

not teach or suggest receiving a plurality of mapping requests from a plurality of other network users identified by a plurality of other network addresses, associating a geographic location in each of the mapping requests with each of the other network addresses, or providing the geographic location associated with the similar network address as the geographic location for the network user. Because Ansell fails to disclose these limitations of claim 1, claim 1 is allowable over the disclosure of Ansell for at least these reasons.

Claims 3-9, 11-14 and 16-21 either depend from claim 1 or have similar limitations as claim 1, and are allowable for at least the same reasons stated above with respect to claim 1. Therefore, Applicant respectfully requests that the rejection under 35 U.S.C. § 102(e) be withdrawn, and all the pending claims be allowed.

Conclusion

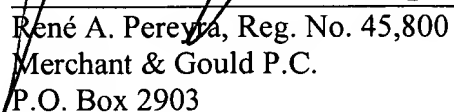
It is believed that no fees are due with this Amendment. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this patent application to deposit account number 13-2725. Moreover, since all of the pending claims are allowable for at least the reasons stated above, Applicant specifically does not acquiesce to any other statements made by the Examiner, which may not be addressed herein, that arguably support the claim rejections.

In light of the above remarks and amendments, it is believed that the application is now in condition for allowance and such action is respectfully requested. Should any additional issues need to be resolved, the Examiner is requested to telephone the undersigned to attempt to resolve those issues.

Respectfully submitted,

Dated: February 13, 2006




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APPENDIX A

Press Release

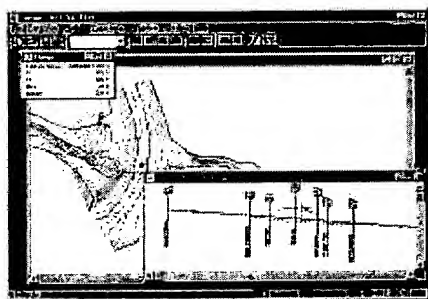
Freeware Surveying and Mapping Software Debuts

November 1, 2000.

Softree Technical Systems Inc. of Vancouver B.C. has announced the release of *Upgrade 2000 for Terrain Tools™* their standalone mapping software.

The Freeware Edition of Terrain Tools (available for download from www.softree.com) allows coordinates to be entered using the mouse, typed in, or imported from external files such as DXF or ASCII. Scanned topographic maps, air photos and other bitmap images can also be incorporated. New features include enhanced drafting, entry of traverses in raw survey format (bearings and distances), custom linetypes, symbols, automatic labeling, and calculation of areas and distances.

Commercial extensions to the Freeware Edition , include support for enhanced field note entry and adjustment, digitizers, digital terrain modeling, contouring, volumes, profiles and road design.



Softree develops and markets surveying, mapping and engineering software for applications in the natural resource industries. For more information contact Craig Speirs at cspeirs@softree.com or (604-519-6222).

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Golfers Rejoice! Golf and Mapping Powerhouses Join Forces to Release Invaluable Golf CD-ROM

YARMOUTH, Maine, May 24, 2000 -- Golf Digest, DeLorme and IntelliGolf® have combined resources to create a powerful software program that will surely become as essential to golfers as a favorite putter. Golf Digest's Places to Play Travel Planner combines information on over 16,000 golf courses with detailed DeLorme digital maps and IntelliGolf scorecard software. People in search of the perfect golf experience will delight in using this novel new program.

Golf Digest's Places to Play is the preeminent guide to golf courses in the U.S. In it, the people who know best - avid golfers from all over the country -- rate more than 6,000 public and resort courses. Golf Digest Places to Play Travel Planner includes the comprehensive information from that guide with 28 categories that include green fees, yardage and ratings. Users will also be able to search for, locate and review information about 10,000 other courses throughout the U.S.

Golf Digest's Places to Play Travel Planner is built on DeLorme's renowned digital mapping software. Using that technology, people will be able to:

- Search for golf courses and details about them within a selected geographic radius
- Create door-to-course directions and maps with accurate course locations
- Print detailed street-level maps for the road
- Locate accommodations and restaurants near courses
- Mobilize maps and directions on Palm Computing organizers
- Connect a laptop to the DeLorme Earthmate GPS receiver and track their positions in real time on maps

IntelliGolf, Golf's #1 Scorecard Software, joins Golf Digest and DeLorme by providing its unrivaled application to Golf Digest Places to Play Travel Planner. With it, users can track scores, putts and drive lengths, calculate approximate handicaps, round averages and view over 60 game-improving statistics on their PCs. They can also use IntelliCourse™ to access over 7,000 golf course scorecards worldwide.

"This is a terrific partnership for the avid golfer," says Bob Carney, Executive Editor Golf Digest Special Projects. "The planner contains the best course information, the best mapping software and the best stats software all in one package. It's a golfer's dream."

Golf Digest's Places to Play Travel Planner is the ultimate tool for people who love to golf and travel. For only \$39.95, golfers can become familiar with courses before they play them. The program is available on CD-ROM and can be purchased directly from DeLorme, 800-452-5931, or the DeLorme Web site, www.delorme.com. It will also be available at major computer retailers.

DeLorme is America's leading map publisher, serving consumers, businesses and professionals. Other DeLorme CD-ROM titles include 3-D TopoQuads®, XMap® Business, Street Atlas USA® 7.0, DeLorme Topo USA® 2.0, Solus Pro 1.5 and Eartha® Global Explorer®, with several titles also

available on DVD-ROM The DeLorme Earthmate GPS Receiver is designed to work with DeLorme software. The company publishes the Atlas & Gazetteer® series of paper topographic maps, available for all 50 states, as well as other paper atlases and maps.

With a record 1.56 million circulation, Golf Digest is the largest golf publication in the world. The magazine is published by The New York Times Company Magazine Group, Inc., a subsidiary of The New York Times Company.

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Magellan Announces the GPS Companion for the Handspring Visor

- Affordable, Versatile Module Provides Detailed Mapping and Navigation -

Santa Clara, Calif. - November 10, 2000 - Magellan Corporation, a leading manufacturer of Global Positioning System (GPS) receivers, today announced its new GPS Companion for the Handspring Visor handheld computer. This sleek, lightweight receiver attaches to the Visor's Springboard expansion slot to provide navigation information and detailed street maps of the entire United States. With the GPS Companion, the Visor becomes the perfect everyday navigation device for mobile professionals, tourists, outdoor enthusiasts and others who want to avoid getting lost. The GPS Companion is due to be released in early 2001.

Magellan has partnered with MarcoSoft, Inc. to provide GPS Companion's exceptional mapping detail and versatility. MarcoSoft developed the MAP Companion software exclusively for Magellan using the award-winning Quo Vadis mapping software platform. Magellan's own NAV Companion software provides users with comprehensive navigation information, including an analog speedometer, a digital compass, and waypoint and route management capabilities. Users can also beam their saved data to other Visor handheld computers.

"Whether for business or recreation, the GPS Companion will give Handspring Visor users the very best mapping and navigation solution available in the U.S., all in a single device," said Steve Schneider, vice president of worldwide sales and marketing for Magellan consumer products. "GPS Companion also has a versatile design and standard interface that offers users the flexibility of expanding the Visor's usefulness by interchanging compatible third party mapping software applications," added Schneider.

"We are excited to see Magellan, a recognized leader in the development of GPS products, develop a location module for the Springboard platform," said Ed Colligan, senior vice president of sales and marketing for Handspring. "As we continue to evolve the Visor product line, adding new functionality to our handhelds, the Springboard platform will be a constant. Products like the GPS Companion are a key component of this strategy."

The boxed GPS Companion and software set has a suggested retail price of \$180.00. Accessories and the Visor by Handspring, Inc. must be purchased separately.

About Magellan Corporation

Magellan Corporation, headquartered in Santa Clara, Calif., is a broad-based satellite access technology company specializing in positioning, navigation, communications and guidance products. A leading manufacturer of handheld GPS receivers and vehicle navigation systems, Magellan is a private company with a majority of stock held by Orbital Sciences Corporation (NYSE: ORB), one of the world's largest, most diversified commercial space products and services companies. For more information about Magellan, visit www.magellangps.com.

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